

REMARKS

This Amendment is in response to the Office action mailed on 20 October 2005 (Paper No. 20051011).

Status of Pending Claims

Claims 38 through 81 are pending in the application. Claim 64 is amended. Claims 1 through 37 were previously canceled without prejudice or disclaimer of their subject matter.

Rejection of Claims 44 and 64 Under 35 U.S.C. §112

Claims 44 and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses both of these rejections for the following reasons.

In support of this rejection, the Examiner argues in essence that Claims 44 and 64 are rejected under the second paragraph of 35 U.S.C. §112 for lack of antecedent basis. The Examiner states that there is no antecedent basis in claim 44 for “the destination” in line 7. Careful examination of claim 44 establishes that there is no “line 7”; moreover, the term “the destination” which appears in line 2, has express antecedent basis in line 8 of parent claim 38.

The Examiner continues by arguing that there is no antecedent basis in claim 64 for “the document” in line 14.” Applicant notes that the preamble of claim 64 reads, “A system

for printing *a document*”

Given the foregoing demonstration of the fallacy of the underlying basis urged by the Examiner in support of this rejection, it may not be maintained and must be withdrawn. 7. Claim 64 is indefinite in that there is no antecedent basis for “the document” in line 14.

Claim Rejections - 35 U.S.C. § 102

- A. Claims 45-53 and 64-71 are rejected under 35 U.S.C. §102(e) as being anticipated by Gross *et al.*, U.S. Patent No. 6,918,082.**

Applicant respectfully traverses the rejection of claims 45-53 and 64-71 under 35 U.S.C. §102(e) as being anticipated by Gross *et al.*, U.S. Patent No. 6,918,082. for the following reasons:

In support of the rejection, the Examiner states that:

Applicant claims an Internet printing apparatus comprising a printing agency server, a memory having stored thereon a customer's choice of attributes for a print job, an editor connected to said first memory, and an output device connected to said first memory. Gross *et al.* disclose an electronic proofing system comprising a document server, a database, and an output device (see Figs. 1 and 2; and col. 8, lines 64-68). Note that this rejection does not give weight to the remainder of the claim limitations because they are intended use for the claimed apparatus. Because the Gross *et al.* apparatus is capable of performing the intended use, Gross *et al.* anticipates the claimed subject matter.

Applicant's claim 45 defines, *inter alia*, apparatus, comprising:

“a printing agency, comprising a server disseminating a home page that, in response to an inquiry by a customer over the World Wide Web, provides instructions explaining how a

customer can request an estimation of cost of a print job and enables a customer to select and to modify attributes of said print job, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job of a first draft received from the customer; said printing agency comprising a memory storing a customer's choice of attributes for said print job and, subsequent to delivery of said estimation to the customer, storing a first draft of said print job composed by the customer independently of said printing agency as a work that is textually distinct from said attributes and that is received from the customer via the World Wide Web; said printing agency comprising an editor connected to said memory to edit said first draft of said print job to create a first revision of said first draft to enable said customer to receive said first revision via the World Wide Web, and to receive from the customer via the World Wide Web, a second draft prepared by the customer in dependence upon said first revision, and to generate a finalized version in dependence upon said second draft; said memory being connected to said editor and storing said finalized version of said print job; and an output device connected to said memory via a network printing to download said finalized version onto a recording media at a location that is geographically compatible with the customer's choice";

while Applicant's claim 64 defines a system comprising:

"a printing agency comprising a server accessible via the Internet, said server providing a port accommodating transmission of information between said print agency and computers of users accessing the Internet; said printing agency comprising an editor editing a manuscript composed by a corresponding one of the users independently of said printing agency with at least one of text, image and pictural components and submitted by the corresponding one of the users to said printing agency to produce the document, said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users; and a first plurality of output devices located at a second plurality of

locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network printing.”

In contradistinction, Gross ‘083 describes “a system which simultaneously displays multiple versions of a portable format document over a computer network,”¹ but which lacks a teaching or suggestion of such salutary features of Applicant’s rejected claims as, by way of example, “a server ... providing instructions ... an estimation of cost ... to modify attributes of said print job”² or “an editor connected to said memory ... to receive from the customer ... a second draft prepared by the customer ...”³, or “an editor editing a manuscript composed by a corresponding one of the users independently of said printing agency ... [and]... disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users ...”⁴ In any interpretation of Gross ‘083, both quotes of cost and the cost of printing and manufacturing are nowhere mentioned; in other words, the needs of a “graphic designer” such as “Roger”⁵ discussed in Gross ‘083 are incompletely addressed by Gross ‘083. *Nicholas V. Perricone, M.D. v. Medicis Pharmaceutical Corporation*, __ F.3d __, #05-1022, -1023 (Fed. Cir. 20 December 2005) citing *Hewlett-Packard Co., v. Mustek Sys., Inc.*, 340 F.3d 1314, 1324 n.6 (Fed. Cir. 2003) “The anticipation analysis asks

¹ Gross ‘082, column 2, lines 63 and 64, claim 1, lines 49 and 50, claim 10, (col. 10) lines 22 and 23, and claim 17, (col. 11) lines 2 and 3.

² Claim 45.

³ Claim 45.

⁴ Claim 64.

⁵ Gross ‘083, column 7, lines 49 and 50.

solely whether the prior art reference discloses and enables the claimed invention, and not how the prior art characterizes that disclosure or whether alternatives are also disclosed.” Here, the foregoing demonstration establishes that Gross ‘083 fails to anticipate the entirety of claims 45 through 53 and 64 through 71; withdrawal of this rejection is therefore required.

B. Claims 45-53 and 64-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Vogt *et al.*, U.S. Patent No. 6,611,349.

Applicant respectfully traverses this rejection for the following reasons:

In support of the rejection, the Examiner states that:

Applicant claims a printing apparatus as noted above. Vogt *et al.* disclose printing a publishing system comprising a document server, a database, and an output device (see Fig. 5). Note that this rejection does not give weight to the remainder of the claim limitations because they are an intended use for the claimed apparatus. Because the Gross *et al.* apparatus is capable of performing the intended use, Gross *et al.* anticipates the claimed subject matter.

Note that if claims 45-53 and 64-71 were interpreted to require the functional limitations recited, these claims would have been an obvious modification of the references discussed below.

These assertions are unfounded on the record before the Examiner.

First, Applicant is confused by the reference by the Examining staff to “Gross *et al.*” in its discussion of this rejection because the rejection is framed as anticipation under 35 U.S.C. §102(e) by Vogt *et al.*, U.S. Patent No. 6,611,349. The express reliance by the Examining staff upon a second reference is convincing evidence of a lack of anticipation. Withdrawal of this rejection is therefore required.

Second, the Examiner argues that “if claims 45-53 and 64-71 were interpreted to require the functional limitations recited, these claims would have been an obvious modification of the references discussed below”; this assertion is unsupported by the applied art, namely Vogt ‘349, and no “modification” is either taught or suggested by Vogt ‘349.

Third, Vogt ‘349 fails to make a *prima facie* demonstration of anticipation. By way of example, although Vogt ‘349 contemplates a class of metadata “stored in the asset tables ... such as cost”, Vogt ‘349 “includes rules limiting ... access to tables indicating the price of products ...”⁶ Consequently, and as is recognized by the Examiner, the fact that “Vogt et al. do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer” rendered Vogt ‘349 unable to anticipate Applicant’s combination; accordingly, there is no anticipation and this rejection may not be sustained.

Claim Rejections - 35 U.S.C. § 103

- C. Claims 38, 39, 43, 45-62, 69-71, 75, 76 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gross *et al.* ‘082 in view of Sevcik *et al.*, U.S. Patent No. 6,330,542.**

Applicant respectfully traverses this rejection for the following reasons:

In support of the rejection, the Examiner states that:

Applicant claims a method a method for printing a document comprising a offering a printing service, receiving, by a merchant from a customer, a request for quote (RFQ) for a print job, said merchant issuing an estimate for said print job, receiving from the customer a first draft of the print job, said

⁶ Vogt ‘349, column 16, lines 17-19 and 36 and 37.

merchant editing said first draft and providing said edited first draft to the customer, generating a revised draft based on said edited first draft, and outputting said revised draft to a remote output device.

Gross et al. disclose a method for providing a printing service comprising a customer creating a draft document (col. 3, lines 54-55, 59-60), a proofer at a printing merchant receiving said draft (col. 3, lines 55-57), said proofer reviewing the draft and commenting on said draft (col. 4, lines 6-11), sending said draft and comments to the customer and said customer revising said draft and returning said revised draft to said printing service (col. 4, lines 25-42), and sending the revised draft to a printing agency for printing (col. 4, lines 42-47).

Gross et al. do not expressly disclose receiving a RFQ and issuing a cost estimate to a customer. However, Sevcik et al. teach a method for issuing a cost estimate for a printing job comprising displaying to a customer a catalog of print services (Fig. 1A, char. 32), receiving from said customer a selection of print services including item specific options (Fig. 1A, char. 63), and issuing to said customer a cost estimate based on said customer selection (Fig. 1A). At the time of Applicant's invention, It was well known that a quoting process could be used to price services. This would have been very desirable for a printing service such as Gross et al.'s since a the variation between customer print jobs prevents a standard price structure. Thus, it would have been obvious to one skilled in the art provide Gross et al.'s service with Sevcik et al.'s quoting process in order to provide a price for custom print jobs.

Note that this rejection does not give patentable weight to the requirement that the customer selects the output device (e.g. claim 55, lines 23-24). This limitation does not change the outcome or effect of the method since the method is designed to provide an edited, printed document. Even if allowing the customer to select the output device were given patentable weight, this distinction does not make Applicant's method patentable as it would have been obvious to make this change. At the time of Applicant's invention, it was customary for a customer (i.e. contractor) to decide which services to outsource. It was also customary for a contractor to select a service provider based on, for example, past experience. Thus, it would have been obvious to allow Gross et al.'s customer to select the

remote output device as provided in the claims.

Applicant's method requires the selection of a number of job-specific options including paper size, paper color, product quantity, enlargement and reduction. The Examiner submits at the time of Applicant's invention, it would have been obvious to one skilled in the art to allow a print customer to choose between these options.

Applicant's method requires correcting the first draft by correcting misspellings, typos and unreadable characters due to software incompatibility. The Examiner submits it would have been obvious to have Gross et al.'s method include these corrections since Gross et al. is drawn to providing a proofing service and making correcting/suggesting corrections would provide value-added service.

The rationale given by the Examiner in support of this rejection ignores the express teachings of the Examiner's proposed combinations. Specifically,

“[f]or every job, there is a series of steps, which occur from when the quote is generated, to when the job is closed. Each of these steps is tracked within the system.”⁷

Absent from the Examiner's proposed combination is any basis for modifying the primary reference. The intensive editing process disclosed by the primary reference is unable to accommodate the icon representative product price menu of the secondary reference. Where precisely is a representation of price to be incorporated into the primary reference except at the completion of publishing? Recognizing that the secondary reference is directed to “aggregating the volume” of multiple products⁸ in order to attain cost savings, while the primary reference is directed to editing of unique, distinctive products which evolve

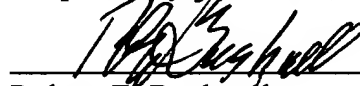
⁷ Sevcik '542, column 15, lines 45 and 55.

⁸ Sevcik '542, column 3, lines 7-35.

throughout the process disclosed by the primary reference, precisely which version of the product in the primary reference serves as the basis for a cost estimation. Recognition that the proposed combination incorporating the cost estimation feature of the secondary reference expressly teaches away from the repetitive iterations which require multiple quotes,⁹ reinforces the total absence of any motivation for modifying the primary reference in the manner urged by the Examiner. Accordingly, this rejection is improper and may not be maintained.

In view of the foregoing explanations and demonstrations of the patentable distinctions between the prior art and Applicant's pending claims, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56332
Date: 4/20/06
I.D.: REB/kf

⁹ See, for instance, Sevcik '542, column 5, lines 20 through 67 and column 6, lines 1 and 2.